



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/009,822 | 12/13/2001 | Mitsuo Osada | Q67726 | 6202 |

23373 7590 08/24/2005
SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

LAVILLA, MICHAEL E

ART UNIT PAPER NUMBER

1775

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/009,822

Applicant(s)

OSADA ET AL.

Examiner

Michael La Villa

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 July 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 December 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 July 2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:
3. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 7-11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - I. Regarding Claims 10 and 11, it is unclear what is meant by the phrase "controlled so that a resultant rolled composite has a controlled coefficient of linear expansion." Applicant has explained that the disclosure at page 17, lines 14-18 and page 18, lines 9 and 22 of the Specification illuminates the meaning of this phrase. However, the cited portions refer to obtaining specific values for CLE for specific embodiments. It is unclear whether applicant contends that the method set forth by these claims is limited to those values of CLE. If

not, it is unclear what is meant by this requirement as any material would be expected to have a CLE value inherently. Hence, it is unclear whether the language is merely superfluous or whether it imposes some definite limitation on the types of products produced by the claimed method.

- II. Regarding Claims 7-11, it is unclear what is meant by the phrase "isotropic coefficient of linear expansion." Applicant's definition of "isotropic," provided at page 5 of the Response of 29 June 2005, is unconventional and without foundation in the Specification. Generally understood, "isotropic" refers to properties that are the same notwithstanding the measurement axis. Moreover, even were the proposed definition acceptable, it is unclear what it means as a limitation in the process. Does this requirement mean that, were one to traverse the product in the final rolling direction, the same CLE value would always be obtained in that direction? Is the more conventional meaning understood which would require measuring the CLE from one point in the product in each direction and always finding the same value? Does it mean something else?

5. The following is a quotation of the first paragraph of 35 U.S.C. 112:
6. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 7-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. It is unclear how applicant's Specification provides support for the invention as now claimed. In other words, it is unclear how the Specification can be said to reasonably convey to one of ordinary skill in the art that applicant was in possession of the claimed invention at the time that the application was filed. Applicant has failed to point to portions of the Specification or otherwise provide convincing arguments that the Specification provides antecedent support for the following claimed features.
8. Regarding Claim 7, it is unclear how isotropic CLE is supported by the original disclosure. In the Specification, most descriptions of CLE refer to CLE values in the final rolling direction or otherwise imply CLE values in the final rolling direction. Generally understood, "isotropic" refers to properties that are the same notwithstanding the measurement axis. With no mentioning of CLE values in other directions, support for isotropic CLE values is not found. Considering applicant's definition of "isotropic," as provided on page 5 of the Response of 29 June 2005, there is no apparent support for the limitation under this interpretation either. In other words, suppose this language suggests that one is to traverse the product in the final rolling direction and always find the same CLE value in

that direction. If so, it is unclear how the Specification provides support.

Nevertheless, were applicant to demonstrate that antecedent support is provided for this claimed subject matter, however defined, applicant's Specification would be objectionable for apparently not using this important claim terminology.

9. The claims as now presented do not specify CLE values in the final rolling direction as were specified in the original disclosure and associated with the various descriptions of applicant's conceptualization of applicant's invention in the original disclosure. Applicant has responded that the claims are enabled. See page 6 of applicant's Response of 29 June 2005. This is not an enablement rejection, however. Applicant also contends that the invention, as now claimed, encompasses the broad principles of the invention, which do not include specific CLE values. It is unclear how applicant arrives at this conclusion in view of the original disclosure. The entire so-called "Disclosure of the Invention" section at pages 7-11 of the Specification makes repeated references to the invention as encompassing a method of making products that achieve specific CLE values. Applicant has provided no persuasive basis for ignoring this disclosure and hence providing support for claims that lack limitations of specific CLE values.

Response to Amendment

10. In view of applicant's amendments and arguments, applicant traverses the section 112, first paragraph rejection of the Office Action mailed on 29 March 2005. Except as recast above for the reasons given above, these rejections are withdrawn.

Art Unit: 1775

11. In view of applicant's amendments and arguments, applicant traverses the section 112, second paragraph rejection of the Office Action mailed on 29 March 2005. Except as recast above for the reasons given above, these rejections are withdrawn.

Conclusion


12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.

13. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 1775

14. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
5 August 2005



MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER